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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/077,456
Filing Date: May 29, 1998
Appellant(s): ANTHONY et al.

Eric Sophir (Reg. No. 48,499)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 2, 2013.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated August 3, 2012 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(2) Response to Argument

Argument A1

Appellant argues that neither of Lawlor, Moss, or Tarbox discloses that the software is installed by a customer (pages 5-6 of the Appeal Brief). Someone must have installed the software at some point (and Lawlor, Moss, and Tarbox all utilize software). A "customer" is just a label for a person. The claims do not specify how any method steps or apparatus structure are affected by the nature of the person doing the installation itself; therefore, clarification of who installed the software does not impart significant patentable weight on the claimed invention. Looking at method claim 1, for example, the installation of the software by the customer is recited as intended use (e.g., "providing user software **for installation** by a customer of the business host on the at least one home banking terminal"). Method/process claims are defined by positively recited steps. "For installation" is an intended use limitation, as opposed to a positively recited step of installing the software; therefore, it does not serve to patentably limit the claimed method over the prior art. Looking at exemplary apparatus claim 33, there is no limiting structure that is capable of or programmed to perform installation. Notably, in an apparatus claim, a human cannot be a limiting element of an apparatus (see MPEP § 2105); therefore, any functionality that a human is recited as performing would not impart patentable weight in an apparatus claim either. In claim 33, the fact that the at least one home banking terminal comprises user software "installed by a customer of the business host" does not mean that the at least one home banking terminal itself

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is programmed to perform the software installation within the scope of claim 33.

At present, a customer installed the user software outside of the scope of claim 33. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. At present, no structural difference results from the fact that the software was (at some point) installed by a customer.

Additionally, none of the claims explain in which context the software installer is a customer of the business host. It is not even required that the customer be the customer (or claimed “user”) performing the financial transaction of the claims.

Argument A2

Appellant argues that an ATM is not a personal computer and, thus, Lawlor is not a relevant reference (pages 6-8 of the Appeal Brief). Appellant explains that “an ATM is a machine that has a limited number of functions, which are generally tailored toward banking transaction” and “a personal computer is a computer that offers nearly unlimited functionality because a user can choose and install new software on the personal computer to give the personal computer more functionality” (page 7 of the Appeal Brief). However, the Examiner points out that these alleged distinctions in ATM and personal computer *capabilities* are not the subject of the claimed invention. Furthermore, Lawlor's ATMs are more akin to terminals that remotely provide typical ATM functionality (Lawlor: col. 8, lines 20-31; col. 19, lines 37-53; col. 21, lines 11-46). In a method claim, the

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nature of any structural elements used to carry out the method only merit patentable weight when they manipulatively affect the steps of the method. At the very least, Lawlor's portable ATM terminal is a functional equivalent to a personal computer. The portable ATM terminal sent to a customer functions as a personal computer (e.g., see the abstract of Lawlor) and is, thus, effectively a type of personal computer within the scope of Lawlor. Furthermore, *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961) states, "As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to such weight in method claims**, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here." In the instant invention, the type of terminal used does not affect the manipulative steps of the method.

Appellant argues that Lawlor teaches away from the use of a personal computer (pages 7-8 of the Appeal Brief). The fact that Lawlor creates a for-home-use ATM terminal that is sent to individuals for their personal use does not necessarily mean that these ATM terminals are not a type of personal computer. The ATM terminal operates as a computer and it is provided to an individual for personal use, thus making it a type of personal computer. The fact that Lawlor is attempting to improve upon previous uses of personal computers does not mean

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that Lawlor's resulting apparatus is not a type of personal computer, especially when the broadest reasonable interpretation is applied.

Argument A3

Appellant argues that the prior art does not address the ability to customize the software in different languages (pages 8-10 of the Appeal Brief). Regarding reliance on the Tarbox reference to further disclose the customization of a financial interface to a user's preferred language, Appellant argues that Tarbox is directed toward a card that stores preferences and therefore "Tarbox cannot teach that installed user software enables the personal computer to allow multiple customers to select from different languages." (Page 9 of the Appeal Brief) In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Lawlor, Moss, and Tarbox are all directed toward providing users with a transaction interface. Each reference contributes elements to make a transaction more convenient for a user. They are analogous art and their teachings are generally relevant to each other. Tarbox expressly teaches that a user interface may be customized to a user-selected language (as seen in col. 1, lines 50-61 and col. 2, lines 55-65 of Tarbox). "Accordingly, it would be beneficial to allow the card user and/or card issuer to personalize the terminal displays and selection options based on his or her own preferences. These personalizations insure that the customer is familiar with the display

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screens, that the screens will be in the proper language for communication, and that the options available are only those desired by the card user or allowed by the card issuer. The customization also allows the financial institution that issued the financial card to assert greater control over the customer's financial behavior." (Tarbox: col. 2, lines 55-65) As explained in the rejection, Tarbox provides motivation to customize any interface to reflect a user's preferred language.

Arguments B and C

In Sections B and C of Appellant's arguments, Appellant reiterates the aforementioned arguments (pages 10-11 of the Appeal Brief). The Examiner's position is maintained for these arguments as well.

Argument D

Appellant argues that the step of "providing user software for installation" provides the antecedent basis for the term "the installed user software." The Examiner respectfully disagrees. "Installation" is recited as intended use and, thus, is not performed within the scope of the method claims. Consequently, the software is never actually installed prior to recitation of the term "the installed user software"; therefore, the Examiner maintains the corresponding rejections under 35 U.S.C. § 112, 2nd paragraph for lack of proper antecedent basis.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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